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EXAMINER

MCALLISTER, STEVEN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,652

Applicant(s)

SIJACIC ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 15-20, 26-30, 36-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 21-25 and 55-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/04, 2/04, 4/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-14, 21-25 and 31-35 in the reply filed on 11/4/2004 is acknowledged. The traversal is on the ground(s) that reasonable examples citing material differences regarding groups I and II; the methods cannot be practiced by hand regarding groups I and III; and groups II and III have not separate utility. This is not found persuasive because:

The examples as provided are reasonable. The system as claimed has means to perform a variety of functions, which reasonably can be combined in different ways than the particular method claims recited. Additionally, the methods as recited can be practiced by hand. While, claims 31-35 mention in the preamble that the method is computer-implemented, no recitation in the body of the claim breathes life into that statement in the preamble.

Regarding groups I and III, while, claims 31-35 mention in the preamble that the method is computer-implemented, no recitation in the body of the claim breathes life into that statement in the preamble.

Regarding groups II and III, as discussed above, the computer as claimed and elements which can accomplish substantively different methods than those claimed.

The requirement is still deemed proper and is therefore made FINAL.

It is noted that claims 55-68 have been examined to the extent necessary to determine if the linking claims are rejected. As a result, it is noted that claims 55-68 are noted as rejected under the rejections of claims 1-14, respectively.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14, 21, 23-25 and 31-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method claims lack a technological element.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites "the dispute resolution process excludes line items in the first invoice that have been approved by the first approver". However, it is not clear whether

this means that the dispute resolution process is conducted only on those items not approved by the first approver; or whether the process acts to exclude line items that have been approved by the first approver.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Randell et al (2002/0194127) and Remington et al (6,070,150) incorporated into '127.

'127 shows receiving a request from a first approver to access invoice data reviewed by another reviewer; providing the data to the approver; receiving a response to dispute (as shown in Remington); and performing dispute handling process with the purchasing entity and the providing entity (as shown in Remington).

As to claim 3, it is noted that '127 in view of Remington show all elements.

As to claim 10, '127 shows sending a notification to a first approver comprising an authorizer; receiving a request from the authorizer to access invoices approved by a second approver, comprising an approver; generating an in-box and making it available

to the authorizer; receiving a selection of a first invoice; receiving an indication reflecting approval of a line item (in view of Remington's dealing with specific line items); and performing dispute resolution on those items not approved by the authorizer (as shown by Remington).

Claims 7-9, 21-25, 31-35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gonen-Friedman et al (2002/0047332).

'332 shows a receiving an indication of a disputed line item from a first entity; sending the information to the second entity; receiving a response from the second entity, where the second entity comprises a resolving entity, and where the response is a disapproval of the dispute; and sending notification to the first entity.

As to claim 21, '332 shows receiving an indication of a disputed line item; assigning the invoice to a first entity within the provider; receiving an indication reflecting whether the dispute is valid; updating the status of the dispute based on the indication; and making the status available to a second entity.

As to claims 22 and 23, it is noted that all elements are shown.

As to claim 24, '332 shows that the first and second entities are associated with the same business entity (since a first entity within the provider decides the status, and the decision is routed through other entities for approval). (e.g., par. 0039, not quite half way down second column).

As to claim 25, the first entity is the deciding entity within the provider and second entity is within the purchasing entity.

As to claims 31-35, all steps are shown.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6 are rejected under 35 U.S.C. 103(a) as obvious over Randell et al (2002/0198830) in view of Gonen-Friedmand et al (2001/0047332).

'830 shows providing information of disputed invoices to a providing entity; receiving a response from the providing entity reflecting whether the dispute is approved; sending a notification to the buying entity; and facilitating a resolution process between the buyer and provider afterwards, comprising allowing the dispute to be placed again via electronic communication (e.g., par. 0063, Fig. 4). '830 does not explicitly show sending a disapproval of the dispute, or disputing particular line items of the invoice. '332 shows these elements. It would have been obvious to one of ordinary skill in the art to modify the method of '830 by providing the elements of '332 in order to provide for provide with specificity what it being disputed and to be able to deal with fraudulent or inadvertently baseless disputes.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over '127 in view of '830.

As to claims 11 and 13, '127 shows all elements of the claim except receiving a response from the providing entity reflecting approval status of the dispute; and notifying a purchasing entity of the status. '830 shows these steps. It would have been obvious to one of ordinary skill in the art to modify the method '127 by receiving and sending to the customer status information of dispute in order to enhance customer satisfaction by providing timely information.

As to claim 12, it is noted that '830 provides for facilitating a direct resolution process between the provider and the purchaser (comprising filing another dispute) upon any resolution of the dispute, and therefore it provides for a direct resolution when the provider disapproved the dispute.

Alternatively as to claim 12, '830 provides all elements except providing a direct resolution process specifically upon a disapproval of the dispute. However, it is notoriously old and well known in the art to provide a resolution method upon rejection of a dispute, such as escalation of the matter to a higher level of management or to arbitration.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonen-Friedman et al ('332).

'332 shows all steps of the claims except receiving a notification reflecting that the purchasing entity has maintained the dispute. However, it is notoriously old and well known in the art to receive such information. It would have been obvious to one of ordinary skill in the art to modify the method of '332 by receiving information indicative of the maintained dispute in order to facilitate an eventual settlement of the case.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister